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**TRANSMITTAL  
FORM**

<b>TRANSMITTAL FORM</b>	Application Number	10/713,308	
	Filing Date	November 14, 2003	
	First Named Inventor	Menke	
	Art Unit	2875	
	Examiner Name	Rehm, Adam C.	
Total Number of Pages in This Submission	12	Attorney Docket Number	54071-42881

**ENCLOSURES (Check all that apply)**

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge \$250.00 for the filing of the Appeal Brief, and any additional fees which may be required, or credit any over-payment, to Deposit Account Number 20-0823. I have enclosed a duplicate copy of this sheet. <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declarations(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Postcard
<b>Remarks</b>		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Thompson Coburn LLP		
Signature			
Printed name	Joseph M. Rolnicki		
Date	April 27, 2006	Reg. No.	32,653

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Joseph M. Rolnicki  
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Reg. No. 32,653

In re application of: Menke, W. Kenneth :

Serial No.: 10/713,308

Examiner: REHM, ADAM C.

Filed: November 14, 2003

Group Art Unit: 2875

For: HOLDER AND HEAT SINK FOR  
HIGH PERFORMANCE LIGHT  
EMITTING DIODE WARNING  
LIGHT ASSEMBLY

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 CFR §41.37

(1) Real Party in Interest

The real party in interest in this appeal is The Fire Products Company by way of an assignment recorded on November 14, 2003, at Reel No. 014707, Frame No. 0737.

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## **(2) Related Appeals and Interferences**

There are no other related appeals or interferences.

## **(3) Status of Claims**

Claims 2 and 4-21 are pending in the application.

Claims 1 and 3 have been cancelled.

Claims 2, 4-6, and 8-13 have been allowed.

Claims 19-21 have been objected to.

Claims 7 and 14-18 have been given a Final Rejection.

The Final Rejection of claims 7 and 14-18 is being appealed.

## **(4) Status of Amendments**

There have been no amendments filed following the Final Rejection of claims 7 and 14-18.

## **(5) Summary of Claimed Subject Matter**

Of claims 7 and 14-18 that have been given a Final Rejection, claims 7 and 14 are independent claims.

### **Claim 7**

The subject matter defined by independent claim 7 is a signal light supporting apparatus 12 (specification page 7, line 23). The apparatus includes a support casing 16 that has a pair of walls 28 with a spacing between the walls 28 (specification page 8, lines 8-13).

A signal light optic 22 is positioned in the spacing between the pair of walls 28 and engages with the walls (specification page 10, line 22-page 11, line 13).

A spring brace 24 is removably attached to at least one of the pair of walls 28 (specification page 11, line 23-page 12, line 2, and page 12, lines 12-14). The spring brace 24 engages with the signal light optic 22 and removably holds the signal light optic 22 in engagement with both of the pair of walls 28 (specification page 11, lines 14-16, and page 12, lines 14-24).

Each wall 28 of the pair of walls 28 has a forward edge 32 with a notch 34 in the forward edge (specification page 8, lines 14-16). The signal light optic 22 has an exterior surface, and portions of the optic exterior surface engage in the notches 34 in the pair of walls 28 (specification page 11, lines 5-13).

#### **Claim 14**

The subject matter of the invention defined by independent claim 14 is a signal light supporting apparatus 12 (specification page 7, line 23). The apparatus has a support casing 16 that has a rear wall 26 (specification page 8, lines 8-9). A plurality of pairs of posts 42 project outwardly from the rear wall 26 (specification page 8, lines 20-23).

The apparatus also includes a plurality of electronic circuit members 18 that each have a light 52 (specification page 2, lines 12-17; and page 9, line 21-page 10, line 2). Each electronic circuit member 18 is removably mounted on the rear wall 26 by engaging between a pair of the posts 42 (specification page 10, lines 9-21, and page 12, lines 3-6).

## **(6) Grounds of Rejection to be Reviewed on Appeal**

Claims 14-18 have been rejected under 35 U.S.C. § 102(a) as being anticipated by the U.S. Patent of Stopa et al. No. 6,641,284. This Final Rejection is presented for review.

Claim 7 has been rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Dart et al. No. 4,124,880. This Final Rejection is presented for review.

## **(7) Argument**

### **Rejection of Claims 14-18 as being Anticipated by Stopa et al. No. 6,641,284**

Of the above-rejected claims, claim 14 is the only independent claim. Among other novel features of the invention, claim 14 recites “a support casing having a rear wall with a plurality of pairs of posts projecting outwardly from the rear wall” and “a plurality of electronic circuit members, each electronic circuit member having a light, and each electronic circuit member being removably mounted on the rear wall by engaging between a pair of posts.”

The above elements of the claimed invention are not identically shown in the Stopa reference, and therefore the Stopa reference does not anticipate claim 14. An anticipation rejection requires that every claimed element be identically shown in the prior art.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

*In re Bond*, 910 F.2d. 831, 15 U.S.P.Q. 2d. 1566, 1567, 1568 (Fed. Cir. 1990).

There are physical differences between the subject matter of the invention recited in claim 14 and the light assembly disclosed by the Stopa reference. A proper anticipation rejection cannot be made when there are physical differences between the subject matter of the invention claimed and the disclosure of the prior art relied on in rejecting the claim.

[A]ny degree of physical difference, however slight,  
invalidates claims of anticipation.

*Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.*, 39 U.S.P.Q. 2d 1969, 1980 (Utah 1996).

In the rejection of claim 14 it is contended that the Stopa reference discloses a plurality of electronic circuit members, with the plurality of circuit members being illustrated in Figures 1 and 9a. It is also contended that each electronic circuit member has a light 42, and that each electronic circuit member is removably mounted on the rear wall by engaging between a pair of posts, again referring to Figure 1. It is also argued that the term “electronic circuit member” can be anything that is a member of a circuit.

The above arguments made in the rejection of claim 14 are all incorrect.

It is first pointed out that claim 14 does not recite only an electronic circuit member. The claim recites a plurality of electronic circuit members, and each electronic circuit member having a light.

In contrast to the above, the Stopa reference discloses only a single electronic circuit member 40, where the single electronic circuit member 40 has a plurality of lights 42. This construction is described in the Stopa reference in column 4, lines 60-65.

The ordinary skilled artisan, when reviewing the Stopa reference, would not interpret the single PC board 40 having the plurality of lights 42 as a plurality of electronic circuit members, with each electronic circuit member having a light. The single PC board 40 is not “a plurality of electronic circuit members” as claimed. The single PC board 40 does not identically show the claimed “plurality of electronic circuit members” as required by the above-cited case law. The single PC board 40 having the plurality of lights 42 does not identically show the claimed plurality of electronic circuit members, with each electronic circuit member having a light.

With the above-noted differences between the subject matter of claim 14 and the disclosure of the Stopa reference, the Stopa reference does not identically show every element of the claimed invention as required by the above case law, and therefore does not anticipate claim 14. The rejection of claim 14 should be reversed, and the claim allowed.

Still further, claim 14 requires that each electronic circuit member be removably mounted on the rear wall by engaging between a pair of posts. This language of claim 14 requires that each electronic circuit member of the plurality of electronic circuit members be removably mounted on the rear wall by engaging between a pair of posts. The Stopa reference also fails to identically show this subject matter of the invention.

The Stopa reference states that fasteners 52 pass through the heat sink 50 and the PC board 40 to engage fastener receptacles 16 molded in the reflector 10. This construction is described in the Stopa reference in column 4, lines 65-67. The PC board 40 is sandwiched or tightly compressed between the rear end of the reflector 10 and the heat sink 50. The compressed relationship is maintained by the fasteners 52

passing through the heat sink 50 and the PC board 40 to engage the fastener receptacles 16 molded in the reflector 10. This construction is described in the Stopa reference in column 5, lines 56-61. Thus, the PC board 40 is held to the heat sink 50 by the fasteners 52 passing through the heat sink 50 and the PC board 40 and engaging in the receptacles 16 of the reflector 10. The PC board 40 is not removably mounted on a rear wall by engaging between a pair of posts as required by claim 14. Furthermore, the single PC board 40 does not identically show the claimed plurality of electronic circuit members, where each electronic circuit member is removably mounted on a rear wall by engaging between a pair of posts. There is no disclosure in the Stopa reference that the PC board 40 even contacts the fasteners 52, much less being removably mounted on a rear wall by engaging between a pair of posts as required by claim 14. Thus, the Stopa reference also fails to identically show this subject matter of the invention recited in claim 14. For this additional reason, the Stopa reference does not anticipate claim 14, and the rejection of the claim should be reversed and the claim allowed.

Claims 15-18 all depend from claim 14, and therefore the subject matter of these claims is not anticipated by the Stopa reference for the same reasons set forth above with regard to claim 14.

Furthermore, claim 17 requires that the plurality of electronic circuit members be electronically connected in series. As explained above, the Stopa reference only discloses the single PC board 40. The reference does not identically show the plurality of electronic circuit members connected in series required by claim 17. For this



additional reason, the Stopa reference does not anticipate claim 17. The rejection of claim 17 should be reversed and the claim allowed.

Claim 18 requires a plurality of optics, with each light having an optic positioned adjacent the light. In the rejection of claim 18, it is contended that these features of the invention are shown by the Stopa reflector parabolic section 14 and the lens 30. However, the reflector parabolic section 14 and lens 30 are provided for the plurality of lights 42 mounted on the PC board 40. The reference does not identically show a plurality of optics with each light having an optic positioned adjacent the light. The Stopa reference discloses a plurality of lights 42 with a single optic 14, 30 positioned adjacent the plurality of lights. For this additional reason, the Stopa reference does not identically show all of the subject matter of the invention recited in claim 18, and does not anticipate the claim. The rejection of claim 18 should be reversed and the claim allowed.

#### **Rejection of Claim 7 as Being Anticipated by Dart et al. No. 4,124,880**

Among other novel features of the invention, claim 7 includes “each wall of a pair of walls having a forward edge with a notch in the forward edge,” and “the signal light optic having an exterior surface with portions of the exterior surface engaging in the notches in the pair of walls.”

In the rejection of claim 7, it is contended that Figure 2 of the Dart reference “illustrates optic 100 engaging the walls and notches thereof.” However, in viewing Figure 2 of the Dart reference, the notches are not visible. The above-cited case law requires that the prior art reference identically show the claimed invention for the reference to anticipate the claim. Because Figure 2 of the Dart reference does not

disclose the claimed notches, Figure 2 does not identically show the subject matter of claim 7, and does not anticipate the subject matter. Figure 2 of the Dart reference cannot identically show portions of the signal light optic exterior surface engaging in the notches in the pair of walls when the figure does not show the notches.

The rejection of the claim also contends that Figure 1 shows a signal light optic 100 "positioned in the spacing between the pair of walls and engaging with both of the pair of walls (Fig. 1) via an exterior surface with portions of the exterior surface engaging the notches in the pair of walls."

In viewing Figure 1 of the Dart reference, only the notch in the wall of the right-hand side signal light is visible. This notch is labeled "C" in the rejection. The signal light optic or lamp 100 is visible through the notch. However, there is nothing that identically shows the lamp 100 extending into the notch. From viewing Figure 1, it is just as likely that the lamp 100 is spaced behind the wall and the notch in the wall, as it is likely that the lamp 100 extends into the notch. There is nothing in Figure 1 that identically shows the subject matter of the invention recited in claim 7. The interpretation of Figure 1 is based on hindsight of the invention. Because Figure 1 fails to identically show the subject matter of the invention recited in claim 7, the Dart reference fails to anticipate the subject matter of the invention under the above-cited case law. The rejection of claim 7 should therefore be reversed, and the claim allowed.

It is respectfully submitted that in view of the remarks presented above, the Final Rejections of claims 7 and 14-18 should be reversed and the claims allowed.

An oral hearing is not requested.

## **(8) Claims Appendix**

- 7) A signal light supporting apparatus comprising:
- a support casing having a pair of walls with a spacing between the walls;
  - a signal light optic positioned in the spacing between the pair of walls and engaging with both of the pair of walls;
  - a spring brace removably attached to at least one of the pair of walls and engaging with the signal light optic, the spring brace removably holding the signal light optic in engagement with both of the pair of walls;
  - each wall of the pair of walls having a forward edge with a notch in the forward edge; and,
  - the signal light optic having an exterior surface with portions of the exterior surface engaging in the notches in the pair of walls.
- 14) A signal light supporting apparatus comprising:
- a support casing having a rear wall with a plurality of pairs of posts projecting outwardly from the rear wall; and,
  - a plurality of electronic circuit members, each electronic circuit member having a light, and each electronic circuit member being removably mounted on the rear wall by engaging between a pair of posts.
- 15) The apparatus of Claim 14, further comprising:
- the rear wall being a heat sink.

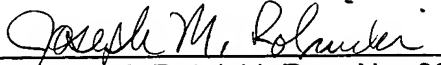
- 16) The apparatus of Claim 14, further comprising:  
each light being a light emitting diode.
- 17) The apparatus of Claim 14, further comprising:  
the plurality of electronic circuit members being electronically connected in  
series.
- 18) The apparatus of Claim 14, further comprising:  
a plurality of optics with each light having an optic positioned adjacent the  
light.

**(9) Evidence Appendix**

None.

**(10) Related Proceedings Appendix**

None.

  
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